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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,075	07/06/2001	Satoshi Hoshino	Q65358	3548

7590 09/23/2009

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EXAMINER	
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ART UNIT	PAPER NUMBER
3693	

MAIL DATE	DELIVERY MODE
09/23/2009	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SATOSHI HOSHINO

Appeal 2009-004475
Application 09/899,075
Technology Center 3600

Decided: September 23, 2009

Before: MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU R. MOHANTY, *Administrative Patent Judges.*

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1 to 8, 14, and 15. We have jurisdiction under 35 U.S.C. § 6(b) (2002). The Appellant appeared for oral hearing on September 9, 2009.

Appellant invented an authenticity checker for driver's license (Spec. 1).

Claim 1 under appeal reads as follows:

> 1. An authenticity checker of driver's license comprising:
> a driver's license image capturing module for image capturing a watermark of a driver's license from both obverse and reverse side; and
> an authenticity judging module which judges the driver's license is a forgery if neither of the watermarks image captured from the obverse nor reverse side by the driver's license image capturing module is recognized as a regular watermark, and judges the driver's license is authentic if at least one of watermarks is recognized as a regular watermark.

Claim 14 under appeal reads as follows:

> 14. A method of authenticating a driver's license, the method comprising:
> gathering first driver's license imaging data based on a watermark on the obverse side of a driver's license, wherein the gathering of first driver's license imaging data further comprises irradiating the driver's license;
> determining if the watermark on the obverse side is regular based on the first driver's license imaging data;

if the watermark on the obverse is determined not regular, gathering second driver's license imaging data based on a watermark on the reverse side of the driver's license, and determining if the watermark on the reverse side is regular based on the second driver's license imaging data, and wherein the gathering of first driver's license imaging data further comprises irradiating the driver's license;

wherein, the driver's license is a forgery if the watermarks on the obverse and reverse sides are both deemed not regular, and the driver's license is authentic if either watermark on the obverse and reverse side is deemed regular.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Kofune US 5,483,069 Jan. 9, 1996

Disclosed Prior Art at pages 1 to 2 of the Appellant's Specification (hereinafter "DPA").

The Examiner rejected claims 1 to 8, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Kofune in view of DPA.

ISSUES

Do the recitations in claims 1 to 8 comply with the requirements of 35 U.S.C. § 112, second paragraph?

Has the Appellant shown that the Examiner erred in finding that Kofune discloses a method in which the bill is judged a forgery if both watermarks from the obverse side and the reversed side are not recognized as a regular watermark as required by claims 14 and 15?

FINDINGS OF FACT

Appellant's Specification discloses:

> it was turned out that there were two kinds of driver's licenses. One is a "face-watermarked type driver's license", whose image data obtained by shooting its obverse show a clear watermark, while the image data of the reverse side do not. The other one is a "back-watermarked type driver's license", whose image data obtained by shooting its backside show a clear watermark, but the image data of the obverse do not. Consequently, the conventional devices that judge the authenticity of a driver's license only by the image data of the obverse may judge an authentic back-watermarked type driver's license to be false by mistake.

(Spec. 1 to 2).

Appellant argues that Kofune does not disclose a watermark on the obverse side and a watermark on the reverse side (App. Br. 13).

Kofune discloses one watermark D (col. 5, ll. 54 to 55; Fig. 8a).

PRINCIPLES OF LAW

Indefiniteness

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*

As the court in *In re Wilson,* 424 F.2d 1382 (CCPA 1970) stated: "All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious- the claim becomes indefinite." *Id.* at 1385.

Obviousness

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.,* 383 U.S. 1, 17-18 (1966). Furthermore, "[']there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness' .... [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex Inc.,* 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

New ground of rejection

Pursuant to 37 C.F.R. § 41.50(b) (2008) we make the following new ground of rejection. Claims 1 to 8 are rejected under 35 U.S.C. § 112,

second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention.

Line 2 of the claim 1 recites "a driver's license image capturing module for image capturing *a* watermark." (Emphasis added). This recitation relates to just one watermark. However, lines 6 and 7 recite that the judging module "judges the driver's license is authentic if at least one of *watermarks* is recognized as a regular watermark." (Emphasis added). This recitation indicates that there is more than one watermark. Therefore, it is not understood whether there is one watermark in accordance with the recitation in line 2 or more than one watermark as recited in lines 6 and 7. It appears that the Specification discloses one watermark that is either on the reverse or obverse side indicating that there is only one watermark. However, Appellant's argument in response to the prior art rejection that Kofune does not disclose a watermark on the obverse side and a watermark on the reverse side seems to indicate that there is a watermark on each side of the driver's license (App. Br. 13). It is unclear whether claim 1 covers an authenticity judging module that compares one watermark from both the obverse and reverse sides or compares a first watermark on the obverse side and a second watermark on the reverse side.

As it is not clear whether claim 1's authenticity judging module judges one or two watermarks, claim 1 and claims 3, 5, and 7 dependent thereon are not in compliance with the requirements of 35 U.S.C. § 112, second paragraph.

Likewise, independent claim 2 recites "*a* watermark" (emphasis added) in line 2 and recites "*watermarks*" (emphasis added) in line 9 and

therefore it is not clear whether claim 2's judging means is judging one or two watermarks. As such, claim 2 and claims 4, 6, and 8 dependent thereon are not in compliance with the requirements of 35 U.S.C. § 112, second paragraph.

Obviousness

In comparing the subject matter of claims 1 to 8 with the applied prior art, it is apparent to us that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection based on prior art cannot be based on speculations and assumptions, *see In re Steele,* 305 F.2d 859, 862 (CCPA 1962), we are constrained to reverse, *pro forma,* the Examiner's rejection of claims 1 to 8 under 35 U.S.C. § 103(a). We hasten to add that this is a procedural reversal rather than one based upon the merits of the rejections.

Claims 14 and 15 recite a method of authenticating a driver's license in which a license having a watermark on the obverse side that is not regular and a watermark on the reverse side that is not regular is determined to be a forgery. Kofune does not disclose a watermark on both the obverse and reverse sides of the bill nor a determination of forgery if neither watermark is regular. As such, we will not sustain the Examiner's rejection of claims 14 and 15.

CONCLUSIONS OF LAW/DECISION

The rejection of the Examiner of claims 1 to 8, 14, and 15 under 35 U.S.C. § 103(a) is not sustained.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED; 37 C.F.R. § 41.50(b)

hh

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